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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,751	09/18/2001	Yeun-Jong Chou	55814US004	8875

32692 7590 10/24/2003

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EXAMINER	
RACHUBA, MAURINA T	
ART UNIT	**PAPER NUMBER**
3723	

DATE MAILED: 10/24/2003 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/954,751	CHOU ET AL.	
	Examiner	Art Unit	
	M Rachuba	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 September 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-16* is/are pending in the application.

4a) Of the above claim(s) *14-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. This application contains claims 14-16 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, and 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al, 5,679,067 in view of Barber, Jr. et al, 5,518,794. '067 discloses a molded abrasive brush having a backing with a plurality of bristles extending therefrom, the backing and bristles being integrally molded (Abstract). The bristles are abrasive,

with the abrasive being either aluminum oxide, diamond, cubic boron nitride, glass beads, glass bubbles, garnet, or silicon carbide (column 12, lines 34-46). The bristles are made of polyamide or polyester (column 9, lines 39-column 10, lines 13. However, '067 disclose that the abrasive is molded throughout the bristle structure, and not adhered to the surface of the bristle. '794, figure 4, teaches, in a unitary brush, but not a brush with hub and bristles molded from the same mass of material, providing each bristle with an adhesive coating (column 10 lines 60-column 11, lines 11), an abrasive coating (column 11, lines 60-column 12, lines 7), and a second adhesive coating (column 23, lines 57-59), the first coating comprising polyurethane (column 10 lines 60-column 11, lines 11), the abrasive comprising for example, silicon carbide, cubic boron nitride, garnet or diamond (column 11, lines 60-column 12, lines 7); the second coating being plastic, considered an adhesive in this product (column 23, lines 57-59). It would have been obvious to one of ordinary skill to have provided '067 with the first and second coating of adhesive and abrasive coating, as taught by '794, column 1, lines 39-47, to prevent the bristles from taking a set shape, softening and losing its effectiveness.

5. As regards claim 8, '794 discloses that the second coating is a plastic material, but not a specific plastic. It would have been obvious to one having ordinary skill in the art at the time the invention was made to *, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. *In re Leshin* states in part

> Mere selection of known plastics to make container-dispenser of a type made of plastics prior to the invention, the selection of the plastics being on basis of suitability for intended use, is obvious.

As it was known to make coatings of plastic, as taught by '794, the selection of a known plastic such as polyurethane, or epoxy or acrylate resins on the basis of its suitability for its intended use would have been obvious to one of ordinary skill at the time the invention was made.

Response to Arguments

6. Applicant's arguments with respect to claims 1 and 3-13 have been considered but are moot in view of the new ground(s) of rejection. In arguing the previous rejection under 35 USC 103, '794 in view of '067, applicant argues that one of ordinary skill would not have made the combination, since abrasive coated filaments are made by a different method than injection molded bristles which contain abrasive. This is not found persuasive. The pending claims are drawn to an apparatus, not a method of making. It appears applicant is arguing that the prior art is non-analogous. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references are both from applicant's field of endeavor, abrasive tools, and '794 is reasonably pertinent to applicant's particular problem, providing a tool with the required flexibility and increased performance. Please refer to column 1, lines 40-47 of '794.

7. Applicant's argument that the method of '067 is contrary to applicant's claimed invention is not well taken. Applicant has claimed (see claim 11) that the bristles comprise abrasive embedded within the bristles. As claimed, the bristles would have to be molded with abrasive material as part of the base material.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning the content of this communication or earlier communications from the examiner should be directed to M. Rachuba whose telephone number is (703) 308-1361. The examiner can normally be reached on Monday through Friday from 8:30 AM to 4:00 PM. Any inquiries concerning other than the content of this and previous communications, such as missing references or filed papers not

acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail, can be reached on (703) 308-2687. The fax phone number for this Group is (703) 872-9302.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

M. RACHUBA
PRIMARY PATENT EXAMINER
ART UNIT 3723

mtr
October 23, 2003